

June 21, 2004
Case No.: PA 893 (2650/4)
Serial No.: 09/924,320
Filed: August 7, 2001
Page 8 of 12

-- REMARKS --

The §102(b) rejection of claims 1, 2, 3, 6, 8, 9, 10, 12, 14, 16 and 27 as anticipated by Yan is traversed. The §102(b) rejection of claims 1 and 2 as anticipated by Stoltze is traversed. The §103(a) rejection of claims 3-10, 12, 14 and 16-27 as unpatentable over Stoltze in view of Hamilton is traversed. Claim 1 has been amended to correct an antecedent basis omission, and not to claim around any references. Claim 22 has been amended to more precisely claim the invention and not to claim around any reference.

Claims 1-3, 6, 8-10, 12, 14, 16 and 27 were rejected as anticipated by Yan

In order to maintain this 102(b) rejection, each and every element of the claimed invention must be disclosed by the reference in at least as great detail as claimed.

The Examiner cites Yan to show that the adhesive "appears to flow into gaps." See Examiner's Response to Arguments. However, the claim requires an inner layer portion and an outer layer portion. Yan does not disclose the claimed *structural* limitations of an inner layer portion and an outer layer portion.

The balloon of the present invention is claimed as including inner and outer layers – thus, the inner and outer layers are included as part of the balloon. At most, Yan discloses that an adhesive is applied to a surface of the balloon. For example, in column 4, lines 4-6, Yan discloses that the "balloon is coated with the heat sensitive adhesive while deflated and the stent is mounted thereon." Additionally, in column 5, lines 46-48, Yan discloses that a "temperature activated adhesive is applied to the surface of the catheter." Furthermore, in column 6, lines 25-30, Yan discloses "applying the adhesive by various methods such as brushing, wiping, spraying, dipping, or like techniques known in the art onto the surface of [the] catheter 10."

Furthermore, claim 9 requires a "non-tacky outer layer." The difference between an adhesive as disclosed by Yan, and a non-tacky outer layer is immediately apparent to those of ordinary skill in the art.

June 21, 2004
Case No.: PA 893 (2650/4)
Serial No.: 09/924,320
Filed: August 7, 2001
Page 9 of 12

In addition, Yan does not disclose that the outer layer comprises a functionalized material, as claimed in claim 6. At most, Yan discloses that the "adhesive" is functionalized, not that the outer layer of the balloon is a functionalized material. See, Yan, column 5, lines 45-56 and column 7, lines 28-34. Claim 8 also requires that the outer layer comprises a functionalized material, and depends from claim 6. Yet further, claim 8 requires that the "functionalized material is not tacky at temperatures *below* the predetermined temperature." (emphasis added) Yan discloses that the functionalized adhesive is not tacky at temperatures *above* the predetermined temperature. See Yan, column 5, lines 52-56. Withdrawal of the rejections to claims 6 and 8 is requested.

Furthermore, Yan does not disclose that the predetermined temperature comprises a temperature range of about 50 to 70 degrees Celsius, as claimed in claims 2 and 16. To the contrary, Yan discloses that the temperature should be about 38 degrees, preferably 40 degrees, but no more than 10 degrees above that temperature. See, Yan column 4, lines 20-25, indicating that the "slight change in blood temperature, up to about 10 degrees C. above normal body temperature, does not affect the health of the patient." Withdrawal of the rejection to claims 2 and 16 is requested on at least this additional basis.

Because Yan does not disclose an inner layer and an outer layer, Yan fails to disclose each and every element of the claimed invention as required for a §102(b) rejection. . Therefore, Applicant respectfully requests that the §102(b) rejection of claims 1, 9, 22 and 27, and claims 2, 3, 6, 8, 10, 12, 14, and 16 depending therefrom be withdrawn.

June 21, 2004
Case No.: PA 893 (2650/4)
Serial No.: 09/924,320
Filed: August 7, 2001
Page 10 of 12

Claims 1 and 2 were rejected as anticipated by Stoltze

In order to maintain this 102(b) rejection, each and every element of the claimed invention must be disclosed by the reference in at least as great detail as claimed.

Stoltze does not disclose a balloon including "an outer layer portion and an inner layer portion" as claimed in claim 1 and therefore, cannot teach each and every element of the claimed invention. At most, Stoltze discloses that the "catheter surface" softens when heating such that pressure applied from the catheter interior depresses the stent into the catheter surface. See, Stoltze, page 14 line 14-page 15 line 5. Claim 2 depends directly from claim 1 and is therefore allowable over the prior art for at least the same reasons.

Withdrawal of the rejections to claims 1 and 2 is requested.

Claims 3-10, 12, 14 and 16-27 were rejected as unpatentable over Stoltze in view of Hamilton

In order to maintain this §103(a) rejection, the references must teach or suggest each and every element of the claimed invention.

Stoltze does not teach or suggest an "inner layer" and an "outer layer" and therefore, cannot teach each and every element of the claimed invention. Likewise, Hamilton does not teach an "inner layer" and an "outer layer." Thus, the references, alone or in combination, cannot teach or suggest the elements claimed in the independent claims 22 and 27 or 3-8, 10, 12, 14, 16-21 and 23-27 depending from independent claims 1, 9 and 22.

June 21, 2004
Case No.: PA 893 (2650/4)
Serial No.: 09/924,320
Filed: August 7, 2001
Page 11 of 12

The "inner layer" and "outer layer" are elements of each and every independent claim (i.e. claims 1, 9, 22, and 27). It appears that the Examiner agrees that Stoltze does not teach or disclose an inner layer and an outer layer. See Examiner's Response to Arguments. Hamilton and Stoltze, individually or in combination, fail to teach or suggest each and every element of the claimed invention as required for a §103(a) rejections. Applicant respectfully requests withdrawal of the §103(a) rejections to claims 3-8, 10, 12, 14, 16-21 and 23-27.

Withdrawal of all rejections is requested.

New claims 28 -33 are allowable over the prior art

Claims 28 -33 are allowable over the prior art, as the prior art does not disclose, teach or suggest each and every element of the claims. Support for the new claims is found on at least paragraphs 25-27 of the specification, on pages 7 and 8.

June 21, 2004
Case No.: PA 893 (2650/4)
Serial No.: 09/924,320
Filed: August 7, 2001
Page 12 of 12

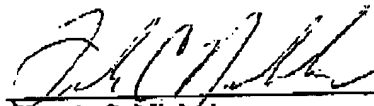
SUMMARY

The Examiner's rejections have been obviated by the above remarks. The Applicant respectfully submits that claims 1-33 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing amendments and remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

Dated: June 21, 2004

Respectfully submitted,
MARK HUANG

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicant